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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/827,584	04/05/2001	Gerhard Albrecht	512425-2059	5913
20999	7590	12/16/2003	EXAMINER	
FROMMERM LAWRENCE & HAUG 745 FIFTH AVENUE- 10TH FL. NEW YORK, NY 10151				EGWIM, KELECHI CHIDI
ART UNIT		PAPER NUMBER		
1713				

DATE MAILED: 12/16/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/827,584	ALBRECHT ET AL.	
	Examiner Dr. Kelechi C. Egwim	Art Unit 1713	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 11/13/03.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 25-34 is/are pending in the application.
  - 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 25-34 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.
 

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. §§ 119 and 120

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.
- 13) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
  - a) The translation of the foreign language provisional application has been received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                             | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____                                    |

## DETAILED ACTION

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 11/13/02 has been entered.

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 25-34 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter that was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The subject matter representing new matter is the definition for "T" in the claims, wherein "T" is defined as:

"-U<sup>1</sup>-O-(C<sub>m</sub>H<sub>l<sub>m</sub></sub>O<sub>m</sub>)<sub>n</sub>-( C<sub>m</sub>H<sub>l<sub>m</sub></sub>O)<sub>o</sub>-R<sup>6</sup>". This formula does not appear in the originally filed specifications.

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 25-34 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

6. As with the previous claims, the newly submitted claims are still generally indefinite. Still no useful prior art search/determination is possible due to the general indefinite nature of the claims.

For instance:

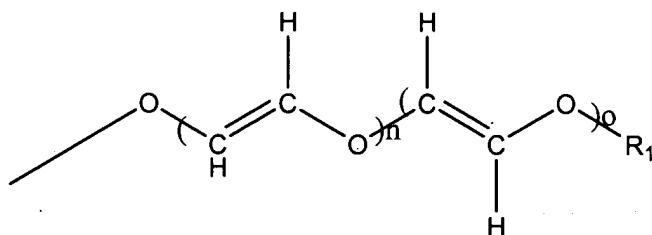
7. The term "oxyalkylenealkylglycol-alkylene ethers" in line 3 of each of claims 25, 27 and 34, from at least one of which the balance of the claims depend, is not art recognized terminology and is not clearly defined in the written description as to put one reasonably skilled in the art in position of what applicant intended to so define by claim term. It is unclear what compounds are to be encompassed or excluded by "oxyalkylenealkylglycol-alkylene ethers".

8. Regarding the variable " $l_m$ " in the claims (see the Final rejection), while applicant does recite in the claims that "the index on the hydrogen atom [are] formed by the

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product of " $i$ " and " $m$ ", one reasonably skilled in the art would still be unclear as to what applicant is intending to define by the formula.

If " $l_m$ " is the index of hydrogen atoms and is the product of " $i$ " and " $m$ ", wherein " $i$ " is "1" or "2", then according to this formula, if " $i$ " is "1" and " $m$ " is "2", " $l_m$ " would be "2" and, according to the claims, X would have the structure:



, which is not consistent with a polyalkylene oxide moiety.

Similarly, in the definition for "T" in the claims, "T" is defined as representing:

$-U^1-O-(C_mH_{l_m}O_m)_n-(C_mH_{l_m}O)_o-R^6$  and " $U^1$ " is defined as representing, among other things, "-O-", which would lead to a peroxide outside of applicant's scope of enablement.

Applicant's formula cannot structurally conflict with the compounds it is indented to represent.

9. Also, claims 25, 27 and 34 each recite:

"where, in the last three radicals,

$V = -O-CO-C_6H_4-CO-O-$ , or  $-W-$ ; or  $-COOR^5$ , in the case where S is --  $COOR^5$  or  $COOM_a$ ;"

However, only **one** of the last three radicals in this recitation even contains a "V" variable.

The claimed formulas are still indefinite.

***Response to Arguments***

10. Applicant's arguments filed 10/24/03 have been fully considered but they are not persuasive. See above.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dr. Kelechi C. Egwim whose telephone number is (703) 306-5701. The examiner can normally be reached on M-T (7:30-6:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on (703) 308-2450. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9310.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-0661.

KCE

KELECHI C. EGWIM PH.D.  
PRIMARY EXAMINER

